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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/750,473	12/31/2003	Rodney R. Wilkins	NFIBX 118	9873
2555 7590 08/20/2007 KREMBLAS, FOSTER, PHILLIPS & POLLOCK 7632 SLATE RIDGE BOULEVARD REYNOLDSBURG, OH 43068			EXAMINER CECIL, TERRY K	
			ART UNIT 1723	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.



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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/750,473
Filing Date: December 31, 2003
Appellant(s): WILKINS ET AL.

MAILED
AUG 20 2007
GROUP 1700

Jason H. Foster
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 5-29-2007 appealing from the Office action mailed 12-27-2006.

Art Unit: 1723

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

No amendment after final has been filed.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct. It is noted that the first paragraph is a summary of independent claim 2 and that the second paragraph is a summary of independent claim 24.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the *first* grounds of rejection to be reviewed on appeal is correct.

NEW GROUND(S) OF REJECTION

The *second* grounds of rejection have been replaced with the following: Whether claims 2-25 are unpatentable under 35 U.S.C. 103 over Brown (U.S. 4,798,850).

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

5,368,734	Wnenchak	11-1994
4,798,850	Brown	01-1989

(9) Grounds of Rejection

The following grounds of rejection are applicable to the appealed claims:

The first grounds of rejection: Claims 2, 22 and 24-25 are rejected under 35 U.S.C. 102(b) as being anticipated by Wnenchak. Wnenchak teaches a filter medium of polypropylene and modacrylic fibers (Technostat), wherein the fibers includes measurable amounts of extractable organic contaminants (lubricants, antistatic agents, etc) as in the table of col. 4, including amounts up to about 0.1%. The samples had a mass of 169.49 g/m² (see col. 4, line 7) resulting in a weight percentage of approximately 0.1% (223.05/169490).

The new second grounds of rejection: Claims 1-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brown (U.S. 4,798,850). Brown teaches a filter material made of a

Art Unit: 1723

blend of (i) polypropylene fibers and (ii) either modacrylic or acrylic fibers (col. 1, line 36 and line 53) and in the claimed ratios of the dependent claims (col. 1, lines 53-65). Brown desires his fibers to be “clean” but doesn’t specify the value of residual contaminants after scouring of the fibers (he doesn’t teach a measurable amount of at least one extractable agent to be less than about 0.1 weight percent). He does however indicate that the effectiveness in removing the contaminants is directly related to the thoroughness of the scouring (col. 2, lines 34-37) and that *if the resulting fibers are moderately clean then the filter will be moderately good* (col. 2, lines 37-38 and lines 49-50). The skilled man in the art would recognize that how well the filter performs is directly related to the amount of residual contaminants after scouring (that cleaner fibers result in a filter that performs better) and that the amount of residual contaminants is directly related to the thoroughness of fiber scouring as well as the thoroughness in cleaning the fiber processing machines (see col. 2, line 67- col. 3, line 6). *For better filter performance*, it would have been obvious to one ordinarily skilled in the art at the time the invention was made to minimize the amount of residual contaminants—to be e.g. less than 0.1 weight percent—by allocating more time, energy, and expense to the cleaning of the fibers and the fiber processing machines.

As for claim 23, Brown teaches that his polypropylene fibers can be made finish free (and not require scouring; see col. 2, lines 31-34). It is also pointed out that claim 23 is a product-by-process limitation. Applicant is reminded that “[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product

Art Unit: 1723

in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." In re Thorpe, 777 F.2d 695,698, 227 USPQ 964; 966 (Fed. Cir. 1985). As shown above, the process of Brown still results in a product filter media having measurable amounts of extractables.

(10) Response to Argument

Concerning the first grounds of rejection, applicant argues that Wnenchak does not teach the extractable contaminants to be "less than about 0.1 weight percent" since the examiner has used the wrong density in his calculations (i.e. used 169.49 g/m² instead of 110 g/m²) to determine the weight percent of contaminants in the TECHNOSTAT blend (i.e. the polypropylene/modacrylic fiber blend, see col. 3, line 53). Though applicant is correct that the TECHNOSTAT samples were 110 g/m² (col. 3, line 55), what he doesn't properly consider is that the results in the table *were given in terms of 169.49 g/m² of material* (see col. 4, lines 8-9). In order to have a proper comparison between the two different types of material blends (each having a different density), the results (the values of milligrams of contaminate per m² of filter material of the table) were converted (by calculations not shown in the reference) into values representative of what would be found in an equivalent amount of material having the same density (i.e. 169.49 g/m² or 169,490 mg/m²). The proper calculation is 223.05/169,490 (both given in terms of mg/m²) = 0.0013 or rounded to the nearest tenth of a percent = 0.1 which the examiner contends is sufficient to anticipate the claim language of the independent claims, i.e. "less than about 0.1 weight percent".

Concerning the second (new) grounds of rejection, applicant's arguments concerning Legare and Wnenchak are no longer relevant, since Brown is now solely used in the rejection (under 103). However in his arguments, applicant has misconstrued the teachings of Brown. Applicant argues (page 8) that Brown "clearly states that its fibers have no coating." However, this does *not* mean his filter hasn't any residual contaminants, as explained in the new second grounds of rejection presented in section 9 above.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

This examiner's answer contains a new ground of rejection set forth in section (9) above. Accordingly, appellant must within **TWO MONTHS** from the date of this answer exercise one of the following two options to avoid *sua sponte* **dismissal of the appeal** as to the claims subject to the new ground of rejection:

(1) **Reopen prosecution.** Request that prosecution be reopened before the primary examiner by filing a reply under 37 CFR 1.111 with or without amendment, affidavit or other evidence. Any amendment, affidavit or other evidence must be relevant to the new grounds of rejection. A request that complies with 37 CFR 41.39(b)(1) will be entered and considered. Any request that prosecution be reopened will be treated as a request to withdraw the appeal.

(2) **Maintain appeal.** Request that the appeal be maintained by filing a reply brief as set forth in 37 CFR 41.41. Such a reply brief must address each new ground of rejection as set forth

Art Unit: 1723

in 37 CFR 41.37(c)(1)(vii) and should be in compliance with the other requirements of 37 CFR 41.37(c). If a reply brief filed pursuant to 37 CFR 41.39(b)(2) is accompanied by any amendment, affidavit or other evidence, it shall be treated as a request that prosecution be reopened before the primary examiner under 37 CFR 41.39(b)(1).

Extensions of time under 37 CFR 1.136(a) are not applicable to the TWO MONTH time period set forth above. See 37 CFR 1.136(b) for extensions of time to reply for patent applications and 37 CFR 1.550(c) for extensions of time to reply for ex parte reexamination proceedings.

Respectfully submitted,

TKC

August 9, 2007



TERRY K. CECIL
PRIMARY EXAMINER

A Technology Center Director or designee must personally approve the new ground(s) of rejection set forth in section (9) above by signing below:

/Gregory Mills/

Gregory Mills

TQAS 1700

Art Unit: 1723

Conferees:

/Jennifer Michener/

Quality Assurance Specialist, TC1700

Jennifer Michener

/David R. Sample/

David R. Sample

Supervisory Patent Examiner